

R E M A R K S

Claims 1 - 112 are pending.

Section 112 Rejections - Multiplicity

Claims 1 - 112 stand rejected as being indefinite from undue multiplicity. Applicants respectfully traverse the Examiner's Section 112 rejection, and have selected certain claims for purpose of examination. The number of claims selected is not greater than the number specified by the examiner.

Selection of Claims for Examination

Claims 1 - 9, 50 - 59, 70 - 74, 77 and 101 are selected for examination. The selected claims are described according to the examiner's groups below:

Group I (10 claims)

Independent method claim 1
Corresponding independent apparatus claim 77
Dependent method claims 2 - 9

Group II (10 claims)

Independent method claim 50
Dependent method claims 51 - 59

Group III (9 claims)

Independent method claim 70
Corresponding independent apparatus claim 101
Dependent method claims 71 - 74

Claims 10 - 49, 60 - 69, 75, 76, 78 - 100 and 102 - 112 are not selected.

Arguments Traversing the Multiplicity Rejection

A rejection for undue multiplicity is only proper where the net effect is confusion as to the claimed invention. The mere number of claims does not afford a basis for rejection under Section 112, or any other statutory provision.

No showing has been made as to why the claims might be considered confusing or otherwise in violation of Section 112, ¶ 2. The only arguments presented relate to the tedious nature of examining 42 independent claims and 70 dependent claims.

Finally, certain dependent claims (exactly which ones was not indicated) may appear repeated, but since they depend from different claims they are not duplicates. In fact, no claims are duplicates.

Accordingly, the rejection should be withdrawn and all pending claims examined on the merits.

Section 112 Rejections - Essential Steps

Claims 9 - 12, 28, 34 - 36 and 39 have been rejected under Section 112, ¶ 2 as "incomplete for omitting essential steps". Applicants respectfully traverse the rejection.

Request for Statutory Basis

The first paragraph of MPEP § 2172.01 states that a rejection for "a claim which omits matter disclosed to be essential to the invention" is to be made under 35 U.S.C. § 112, first paragraph. Accordingly, an essential elements rejection is a rejection for lack of enablement of the claimed invention, not indefiniteness. See, first paragraph of MPEP § 2172.01. Given the statement that the rejected claims are "incomplete for omitting essential steps", Applicants proceed under the assumption that the rejection of these claims was intended to be made under 35 U.S.C. § 112, first paragraph.

However, a claim which fails to *interrelate* essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. Second paragraph of MPEP § 2172.01. Applicants do not believe any such allegation has been made. Nevertheless, if the rejection of these claims was intended to be one for failure to *interrelate* essential elements, Applicants respectfully request that the Examiner indicate which essential elements of the claims must be, but are currently not, interrelated.

No Evidence That These Are in Fact Essential

With respect to the rejection of the claims based on "omitting essential steps", these rejections are improper. According to MPEP § 2172.01, such essential elements must be described *by the applicant(s) as necessary* to practice the invention. Similarly, according to MPEP § 2164.08(c), an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of *the specification makes it clear* that the limitation is *critical* for the invention to function as intended. Nowhere in the specification have the allegedly "essential steps" been described as necessary to practice the invention, and the Examiner has not so asserted.

Further, a rejection based on the failure to satisfy this requirement is appropriate only where applicant has stated, *somewhere other than in the application as filed*, that the invention is something different from what is defined by the claims. MPEP 2172(I). Nowhere have the allegedly "essential steps" been described as necessary to practice the invention, and the Examiner has not so asserted.

Broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality. MPEP § 2164.08(c). Applicants note that the present specification in fact discloses several embodiments that omit the allegedly essential features.

The invention set forth in the claims must be presumed, in the absence of evidence to the contrary, to be that which applicants regard as their invention. MPEP 2172(I). There is no evidence to the contrary, and the Examiner has not so asserted.

Certain Types of Limitations are not Essential

The Examiner has not provided any evidence in support of the stated position that essential steps are missing. The Arguments set forth on page 4 of the Office Action are generally that (i) certain features (e.g., "creating the databases") are required to enable the claimed

invention, and (ii) certain features are required otherwise the claim could be interpreted very broadly (e.g., "these items could just be sitting there and looping").

First, it is not necessary to claim in a patent every device required to enable the invention to be used. *Asyst Tech. Inc. v. Empak Inc.*, 268 F.3d 1364 (Fed. Cir. 2001).

Second, features which are merely preferred (for certain embodiments) are not to be considered critical, and thus need not be recited in claims. MPEP § 2164.08(c).

Also, the fact that a claim is broad and reads on many embodiments does not necessarily make it indefinite.

Notwithstanding the above reasons why the essential elements rejection is unfounded, claim 9 has been amended.

Section 112 Rejections - Antecedent Basis

Claim 64 has been amended to correct the antecedent basis discrepancy noted by the Examiner.

Section 101 Rejections - Directed to a Human Being

Claims 29 - 30 and 32 - 33 stand rejected as being non-statutory for being directed to or including within their scope a human being or attributes of a human being. Applicants respectfully traverse the Examiner's Section 101 rejection.

Each of these dependent claims is directed to a method which involves actions which may be performed, in part, by a person. None of these method claims, in even the broadest interpretation, encompasses a human being (or any other product). The prohibition indicated by the Examiner is limited to claims which encompass a human being (as opposed to, e.g., other living organisms). Accordingly, the rejected method claims are statutory and the rejection should be withdrawn.

Section 101 Rejections - Human Being

Claims 1 - 76 and 109 - 112 stand rejected as being non-statutory for not involving the technological arts. Applicants respectfully traverse the Examiner's Section 101 rejection.

Applicants Understanding of the Standard Used

The Office Action on pages 5 - 6 sets forth the two-part test that was applied to the rejected claims. The second prong of this test is "whether the invention produces a useful, concrete, and tangible result". There is a statement on page 6 that "the claimed invention provides for an indication of at least one supplemental product selected from the pool (i.e. repeatable, useful and tangible)".

Applicants interpret this statement and the remainder of the rejection as an assertion that the rejected claims satisfy the second prong, but not the first prong, of the two-prong test. If Applicants are incorrect, clarification is respectfully requested.

Applicants understanding according to pages 5 - 6 is that, in order to be considered statutory, a method claim must not be performable by a human without a computer. For example, the Examiner states "[a]ll of these steps can be performed by a human being and done by hand and utilizing just pencil and paper." Office Action, page 6.

Request

If this rejection is maintained, Applicants respectfully request an appropriate and explicit basis for this test. Specifically, Applicants respectfully request clarification as to which of the following is the basis for the Examiner's two-prong test:

- (a) this test is believed to be in accordance with some section of the MPEP, or instead
- (b) this test is a policy of the U.S. Patent and Trademark Office.

If the basis is (a), the rejection should be withdrawn because no section of the MPEP sets forth such a test for statutory subject matter. Further, Applicants are unaware of any statute or court decision supporting this test.

Applicants also note that this standard (not performable by a human) is clearly contrary to law. See, e.g., Alco Standard Corp. v. Tennessee Valley Authority, 808 F.2d 1490, 1496, 1 USPQ2d 1337, 1341 (Fed. Cir. 1986) ("The inclusion in a patent of a claim to a process that may be performed by a person, but that is also capable of being performed by a machine, is not fatal to patentability. The presence of the steps of correlating and combining, which a machine is capable of doing, does not invalidate a patent."); See, also, Musco Corp. v. Qualite, Inc., Civ. Application, 106 F.3d 427, 1997 WL 16031 (Fed. Cir. 1997), (per curiam)(unpublished), cert. denied, 118 S. Ct. 60 (1997) ("The existence of mental steps in the claims or specification of a patent do not, in and of themselves, invalidate the patent.")

If the basis is (b), please clarify whether this two-prong test relies on a new statutory interpretation of 35 U.S.C. § 101 that has been adopted by the U.S. Patent and Trademark Office.

Proper Standard

The Federal Circuit has made it clear that the only issue in determining the presence of statutory subject matter is whether the claimed invention produces a useful, concrete, tangible result. Since the Examiner apparently agrees (from the statement on page 6) that the invention produces a useful, concrete, tangible result, the rejection should be withdrawn.

Conclusion

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Dean Alderucci at telephone number 203-461-7337 or via electronic mail at Alderucci@WalkerDigital.com.

Petition for Extension of Time to Respond

Applicants hereby petition for a **three-month** extension of time with which to respond to the Office Action. Please charge \$465.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an extension of time is required, or if an additional extension of time is required in addition to that requested in a petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,



Dean Alderucci
Attorney for Applicants
Registration No. 40,484
Alderucci@WalkerDigital.com
203-461-7337 / voice
203-461-7300 / fax

September 11, 2003
Date